

IN THE DRAWINGS

The attached sheets of drawings include changes to Figs.7 and 8. These sheets, which include Figs.7 and 8, replace the original sheets including Figs. 7 and 8.

Attachment: Replacement Sheets

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion is respectfully requested.

Claims 1-8 are pending in the application; Claims 1-3 and 7 are amended and Claim 8 is added by the present amendment. No new matter is added.

In the outstanding Official Action, the drawings are objected to as including informalities; Claim 7 is objected to as being in improper form; Claims 1-7 are rejected under 35 U.S.C. §112, second paragraph, as indefinite; Claims 1 and 2 are rejected under 35 U.S.C. §102(e) as anticipated by Fang et al. (U.S. Pat. No. 6,788,257, herein "Fang"); and Claims 3-7 are rejected under 35 U.S.C. §103(a) as unpatentable over Fang in view of Lubitz (U.S. Pat. No. 5,593,612).

In regard to the objection to the drawings, Figures 7 and 8 have been amended to include the legend "Related Art". Accordingly, Applicants respectfully request that the objection to the drawings be withdrawn.

In regard to the objection to Claim 7 as being in improper form, Claim 3 has been amended to depend from only Claim 1. Accordingly, as the multiple dependent Claim 7 no longer depends from a multiple dependent claim, Applicants respectfully request that the objection to Claim 7 be withdrawn.

In regard to the rejection of Claims 1-7 under §112, second paragraph, Claims 1, 2 and 7 have been amended to correct the antecedent basis of the features of the claims. Accordingly, Applicants respectfully request that the rejection of Claims 1-7 under §112, second paragraph be withdrawn.

Turning now to the rejections of the Claims under §§102 and 103, these rejections are respectfully traversed.

Claim 1 recites, in part,

an insulative material layer which has relative magnetic permeability greater than 1 and is placed in a gap between a radiating conductor and said reference conductor.

Claim 2 recites similar features.

Fang describes a dual-frequency planar antenna that includes a medium used to separate the radiator and the grounding plane and is positioned between the two. Further, Fang describes that the material of medium 150 can be air, dielectric substrate or the combination of them.<sup>1</sup>

However, Fang does not describe or suggest an insulative material layer which has relative magnetic permeability greater than 1.

As noted above, Fang describes that material of medium 150 can be air, dielectric substrate or the combination of them, however, these materials are not describes as having a relative magnetic permeability greater than 1.

Therefore as Fang does not describe every feature of the invention as recited in Claim 1, Claim 1 and similarly Claim 2, and claims depending therefrom, patentably distinguish over Fang.

With regard to the rejection of Claims 3-7 under §103(a), Applicants respectfully traverse this rejection.

The outstanding Office Action admits on page 5, lines 1-2 that Fang does not describe an insulative material layer made of an oxide magnetic material comprising a Y, Z, or M-type hexagonal ferrite.

Instead the outstanding Action relies on Lubitz as teaching the above noted feature.

Lubitz describes a hexagonal ferrite, however it would not have been obvious to one skilled in the art to use the hexagonal ferrite of Lubitz in the separating medium of the antenna disclosed in Fang.

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<sup>1</sup> Fang, col. 1, lines 37-52.

The outstanding Office Action states that the proposed modification would have been obvious "in order to provide a hexagonal ferrite which can be shifted over a range of frequencies as desired."

However, the separating medium of Fang is not concerned with shifting a range of frequencies. Instead, Fang states that its structure already achieves the goal of separating the grounding plane and the radiator. Fang does not suggest that further improvement is desired, nor that another feature should be added to further improve the separation. In particular, Fang does not suggest adding hexagonal ferrite, such as is disclosed in Lubitz.

Fang and Lubitz, therefore, do not provide the motivation to perform the proposed modification of the medium of Fang. In other words, an attempt to bring in the isolated teaching of Lubitz into Fang would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.<sup>2</sup> While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record.<sup>3</sup> In this case, the record fails to support the proposed modification of the Fang system.

In rejection a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record, and by "clear and particular" evidence of the suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying Fang's device by incorporating Lubitz's device. Without

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<sup>2</sup> See In re Ehrreich 590 F.2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

<sup>3</sup> In re Lee, 277 F.3d 1338, 1343-4, 61 USPQ2d 1430 (Fed. Cir. 2002) ("The factual inquiry whether to combine references ... must be based on objective evidence of record. ... [The] factual question of motivation ... cannot be resolved on subjective belief and unknown authority. ... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion").

such motivation and absent improper hindsight reconstruction,<sup>4</sup> a person or ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 3-7 and similarly added Claim 8 are believed to be non-obvious and patentable over the applied prior art.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 1-8 is patentably distinguishing over the prior art. The present application is therefore believed to be in condition for a formal allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

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<sup>4</sup> See M.P.E.P. § 2141, stating, as one of the tenants of patent law applying to 35 U.S.C. § 103, that "the references must be viewed without the benefit of impermissible hindsight vision of afforded by the claimed invention."